From: Assistant Deputy Comm (ADCs)
Sent: Thursday, April 5, 2018 10:16:23 AM
Subject: Dynamic Drinkware-Amgen II memorandum [102(e)]

This email is being sent to all Directors, SPEs, and Examiners Employees in the Technology Centers.

The attached memorandum concerns the situation in which a U.S. patent application publication or a published PCT application is being used as prior art under pre-AIA 35 U.S.C. § 102(e).

The January 2018 publication of the MPEP revised § 2136.03 to indicate a new requirement that: for a U.S. patent that claims benefit of a prior provisional application, the critical reference date under pre-AIA 35 U.S.C. § 102(e) of the patent (i.e., the date the U.S. patent is effective as prior art under pre-AIA 35 U.S.C. § 102(e)) may be the filing date of the provisional application **only** if at least one of the claims in the U.S. patent being used as a prior art under pre-AIA 35 U.S.C. § 102(e) is supported by the written description of the provisional application in compliance with pre-AIA 35 U.S.C. § 112, first paragraph. This requirement is based upon a 2015 decision by the U.S. Court of Appeals for the Federal Circuit (Federal Circuit) in *Dynamic Drinkware, LLC, v. National Graphics, Inc.,* 800 F.3d 1375 (Fed. Cir. 2015). The January 2018 publication of the MPEP is current as of August 31, 2017.

The attached memorandum indicates that this new requirement is also applicable when a U.S. patent application publication or a published PCT application is being used as prior art under pre-AIA 35 U.S.C. § 102(e). This is a change in practice from what is stated in MPEP § 2136.03, and is the consequence of a Federal Circuit decision (*Amgen v. Sanofi*, 872 F.3d 1367 (Fed. Cir. 2017)), which was decided after the revision date of the January 2018 publication of the MPEP.

Robert Bahr
Deputy Commissioner
for Patent Examination Policy

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MEMORANDUM

DATE: April 5, 2018

TO: Patent Examining Corps

FROM: Robert W. Bahr
Deputy Commissioner
for Patent Examination Policy

SUBJECT: **Critical reference date under pre-AIA 35 U.S.C. § 102(e) of a U.S. patent or U.S. published application claiming the benefit of a prior U.S. provisional application during examination of an application**

MPEP § 2136.03 was recently revised[1] to indicate that for a U.S. patent that claims benefit of a prior U.S. provisional application, the critical reference date under pre-AIA 35 U.S.C. § 102(e) of the patent may be the filing date of the provisional application **only** if at least one of the claims in the patent is supported by the written description of the provisional application in compliance with pre-AIA 35 U.S.C. § 112, first paragraph, citing *Dynamic Drinkware, LLC, v. National Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015).[2]

The U.S. Court of Appeals for the Federal Circuit (Federal Circuit) recently extended this principle to published patent applications that have a prior art effect under pre-AIA 35 U.S.C. § 102(e).[3] *See Amgen v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017). Thus, the critical reference date under pre-AIA 35 U.S.C. § 102(e) of a U.S. patent, a U.S. patent application publication, as well as an international application publication having prior art effect under pre-AIA 35 U.S.C. § 102(e), may be the filing date of a relied upon provisional application **only** if at least one of the claims in the reference patent, patent application publication, or international application publication is supported by the written description of the provisional application in compliance with pre-AIA 35 U.S.C. § 112, first paragraph. Consistent with prior guidance, the provisional application must also describe the subject matter relied upon in the patent, patent

[1] The January 2018 Publication of Revision 08.2017 of the Ninth Edition of the MPEP (January 2018 MPEP Publication).

[2] The January 2018 MPEP Publication also revised the examiner notes accompanying four form paragraphs (7.12.fti examiner note 2, 7.12.01.fti examiner note 4, 7.15.02.fti examiner note 4, and 7.15.03.fti examiner note 4).

[3] A Patent Cooperation Treaty (PCT) international application has a prior art effect under pre-AIA 35 U.S.C. § 102(e) if it: (1) designated the United States; (2) was published under PCT Article 21(2) in English; and (3) has an international filing date on or after November 29, 2000. See MPEP § 2136, subsection II.

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application publication, or international application publication to make the rejection. See MPEP § 2136, subsection III.

Examiner note 2 of form paragraph 7.12.fti, examiner note 4 of form paragraph 7.12.01.fti, examiner note 4 of form paragraph 7.15.02.fti, and examiner note 4 of form paragraph 7.15.03.fti have been revised effective immediately. A clean copy of the form paragraphs with updated examiner notes is attached to this Memorandum.

The MPEP will be updated in due course to incorporate the changes effected by this memorandum.

The requirement that one of the claims in the patent, patent application publication, or international application publication be supported by the written description of the provisional application in compliance with pre-AIA 35 U.S.C. § 112, first paragraph (or AIA 35 U.S.C. § 112(a)), is not applicable when examining an application subject to the first inventor to file provisions of the AIA (*i.e.*, "AIA applications). *See Dynamic Drinkware,* 800 F.3d at 1381 n.2; *see also* 157 Cong. Rec. S1369-70 (Mar. 8, 2011) (explaining the distinction between being entitled to claim priority or benefit in AIA 35 U.S.C. § 102(d) and actually being entitled to priority or benefit under 35 U.S.C. § 119, 120, or 365). The date subject matter was "effectively filed" under AIA 35 U.S.C. § 102(d) for purposes of considering a U.S. patent, a U.S. patent application publication, or an international application publication as prior art under AIA 35 U.S.C. § 102(a)(2) is discussed in MPEP § 2154.01(b), and is not affected by *Dynamic Drinkware* or *Amgen* and is not being modified by this memorandum.

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¶ 7.12.fti Pre-AIA 35 U.S.C 102(e), Patent Application Publication or Patent to Another with Earlier Filing Date, in view of the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Examiner Notes:

1. This form paragraph should only be used if the reference is one of the following:

   (a) a U.S. patent or a publication of a U.S. application for patent filed under 35 U.S.C. 111(a);

   (b) a U.S. patent issued directly or indirectly from, or a U.S. or WIPO publication of, an international application (i.e., a PCT application) if the international application has an international filing date on or after November 29, 2000;

   (c) a U.S. patent issued from, or a WIPO publication of, an international design application that designates the United States.

2. In determining the pre-AIA 35 U.S.C. 102(e) date, consider benefit claims to earlier-filed U.S. provisional applications under 35 U.S.C. 119(e), and to earlier-filed U.S. nonprovisional applications and international applications under 35 U.S.C. 120, 121, 365(c), or 386(c) if the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application's disclosure (and any intermediate application(s)). Do NOT consider foreign priority claims under 35 U.S.C. 119(a) - (d), 365(a) or (b), or 386(a) or (b).

   In addition, a reference (i.e., a U.S. patent, published U.S. patent application, or WIPO publication) is entitled to the benefit of the filing date of a provisional application only if at least one of the claims in the reference is supported by the written description of the provisional application in compliance with 35 U.S.C. 112(a). See *Dynamic Drinkware, LLC, v. National Graphics, Inc.*, 800 F.3d 1375, 116 USPQ2d 1045 (Fed. Cir. 2015) and *Amgen v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017).

3. In order to rely on an international filing date for prior art purposes under pre-AIA 35 U.S.C. 102(e), the international application (PCT) must have been filed on or after November 29, 2000, it must have designated the U.S., and the international publication under PCT Article 21(2) by WIPO must have been in English. If any one of the conditions is not met, the international filing date is not a U.S. filing date for prior art purposes under pre-AIA 35 U.S.C. 102(e).

4. If an international application (PCT) was published by WIPO in a language other than English, or did not designate the U.S., the international application's publication by WIPO, the U.S. publication of the national stage application (35 U.S.C. 371) of the international application and a U.S. patent issued from the national stage of the international application may not be applied as a reference under pre-AIA 35 U.S.C. 102(e). The reference may be applied under pre-AIA 35 U.S.C. 102(a) or (b) as of its publication date. See form paragraphs 7.08.fti and 7.09.fti.

5. If an international application (PCT) was published by WIPO in a language other than English, the U.S. publication of, or a U.S. patent issued from, a continuing application claiming benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to such an international application, has a pre-AIA 35 U.S.C. 102(e) date as of the earliest U.S. filing date after the international filing date.

6. If the reference is a U.S. patent issued directly, or indirectly, from an international application (PCT) that has an international filing date prior to November 29, 2000, use form paragraph 7.12.01.fti. In that situation, pre-AIPA 35 U.S.C. 102(e) is applicable in the determination of the prior art date of the patent issued from such an international application.

7. If the reference is a publication of an international application (PCT), including the U.S. publication of a national stage (35 U.S.C. 371), that has an international filing date prior to November 29, 2000, do not use this form paragraph. Such a reference may not be applied as a prior art reference under pre-AIA 35 U.S.C. 102(e). The reference may be applied under pre-AIA 35 U.S.C. 102(a) or (b) as of its publication date. See form paragraphs 7.08.fti and 7.09.fti.

8. This form paragraph must be preceded by form paragraph 7.07.fti, and may be preceded by one or more of form paragraphs 7.08.fti to 7.11.fti.

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¶ 7.12.01.fti Pre-AIPA 35 U.S.C. 102(e), Patent to Another with Earlier Filing Date, Reference is a U.S. Patent Issued Directly or Indirectly From a National Stage of, or a Continuing Application Claiming Benefit to, an International Application Having an International Filing Date Prior to November 29, 2000

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (**pre-AIPA** 35 U.S.C. 102(e)).

Examiner Note:

1. This form paragraph should only be used if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under 35 U.S.C. 371) which has an international filing date prior to November 29, 2000, or a continuing application claiming benefit to an international application having an international filing date prior to November 29, 2000.
2. If the reference is a U.S. patent issued directly from a national stage of such an international application, the reference's **pre-AIPA** 35 U.S.C. 102(e) date is the date that the requirements of 35 U.S.C. 371(c)(1), (2) and (4) were fulfilled. The language of WIPO publication (PCT) is not relevant in this situation. Caution: the international publication of the international application (PCT) by WIPO may have an earlier prior art date under pre-AIA 35 U.S.C. 102(a) or pre-AIA 102(b).
3. If the reference is a U.S. patent issued directly from a continuing application claiming benefit under 35 U.S.C. 120, 121 or 365(c) to such an international application (which had not entered the national stage prior to the continuing application's filing date, otherwise see note 4), the prior art reference's **pre-AIPA** 35 U.S.C. 102(e) date is the actual U.S. filing date of the continuing application. Caution: the international publication of the international application (PCT) by WIPO may have an earlier prior art date under pre-AIA 35 U.S.C. 102(a) or pre-AIA 102(b).
4. In determining the **pre-AIPA** 35 U.S.C. 102(e) date, consider benefit claims to earlier-filed U.S. provisional applications under 35 U.S.C. 119(e), and to earlier-filed U.S. nonprovisional applications and international applications under 35 U.S.C. 120, 121, 365(c), or 386(c) only if the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application's disclosure (and any intermediate application(s)). A benefit claim to a U.S. patent of an earlier-filed international application may only result in an effective U.S. filing date as of the date the requirements of 35 U.S.C. 371(c)(1), (2) and (4) were fulfilled. Do NOT consider any benefit claims to U.S. applications which are filed before an international application. Do NOT consider foreign priority claims under 35 U.S.C. 119(a) - (d), 365(a) or (b), or 386(a) or (b).

In addition, a reference (i.e., a U.S. patent, published U.S. patent application, or WIPO publication) is entitled to the benefit of the filing date of a provisional application only if at least one of the claims in the reference is supported by the written description of the provisional application in compliance with 35 U.S.C. 112(a). See *Dynamic Drinkware, LLC, v. National Graphics, Inc.*, 800 F.3d 1375, 116 USPQ2d 1045 (Fed. Cir. 2015) and *Amgen v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017).

5. This form paragraph must be preceded by form paragraph 7.07.fti, and may be preceded by one or more of form paragraphs 7.08.fti to 7.11.fti.

¶ 7.15.02.fti Rejection, Pre-AIA 35 U.S.C. 102(e), Common Assignee, Applicant, or Joint Inventor

Claim(s) **[1]** is/are rejected under pre-AIA 35 U.S.C. 102(e) as being anticipated by **[2]**.

The applied reference has a common **[3]** with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under pre-AIA 35 U.S.C. 102(e). This rejection under pre-AIA 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor or joint inventors (i.e., the inventive entity) of this application and is thus not the invention "by another," or if the same invention is not being claimed, by an appropriate showing under 37 CFR 1.131(a).

Examiner Note:

1. This form paragraph is used to reject over a patent or patent application publication with an earlier effective filing date. The patent or patent application publication must have either a common assignee, a common applicant (35 U.S.C. 118), or a common joint inventor.
2. Pre-AIA 35 U.S.C. 102(e) as amended by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 (form paragraph 7.12.fti) must be applied if the reference is by another and is one of the following:

a. a U.S. patent or a publication of a U.S. application for patent filed under 35 U.S.C. 111(a);

b. a U.S. patent issued directly or indirectly from, or a U.S. or WIPO publication of, **an international application (PCT) if the international application has an international filing date on or after November 29, 2000**;

c. a U.S. patent issued from, or a WIPO publication of, an international design application that designates the United States.

See the Examiner Notes for form paragraph 7.12.fti to assist in the determination of the pre-AIA 35 U.S.C. 102(e) date of the reference.

3. Pre-AIPA 35 U.S.C. 102(e) (form paragraph 7.12.01.fti) must be applied if the reference is a U.S. patent issued directly, or indirectly, from an international application filed prior to November 29, 2000. See the Examiner Notes for form paragraph 7.12.01.fti to assist in the determination of the pre-AIPA 35 U.S.C. 102(e) date of the reference.
4. In determining the pre-AIA 35 U.S.C. 102(e) date, consider benefit claims to earlier-filed U.S. provisional applications under 35 U.S.C. 119(e), and to earlier-filed U.S. nonprovisional applications and international applications under 35 U.S.C. 120, 121, 365(c), or 386(c) if the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application's disclosure (and any intermediate application(s)). A benefit claim to a U.S. patent of an earlier-filed international application, which has an international filing date prior to November 29, 2000, may only result in an effective U.S. filing date as of the date the requirements of 35 U.S.C. 371(c)(1), (2) and (4) were fulfilled. Do NOT consider any benefit claims to U.S. applications which are filed before an international application that has an international filing date prior to November 29, 2000. Do NOT consider foreign priority claims under 35 U.S.C. 119(a) - (d), 365(a) or (b), or 386(a) or (b).

In addition, a reference (i.e., a U.S. patent, published U.S. patent application, or WIPO publication) is entitled to the benefit of the filing date of a provisional application only if at least one of the claims in the reference is supported by the written description of the provisional application in compliance with 35 U.S.C. 112(a). See *Dynamic Drinkware, LLC, v. National Graphics, Inc.*, 800 F.3d 1375, 116 USPQ2d 1045 (Fed. Cir. 2015) and *Amgen v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017).

5. If the reference is a publication of an international application (PCT), including voluntary U.S. publication under 35 U.S.C. 122 of the national stage or a WIPO PCT publication, that has an international filing date prior to November 29, 2000, did not designate the United States or was not published in English by WIPO, do not use this form paragraph. Such a reference is not a prior art reference under pre-AIA 35 U.S.C. 102(e). The reference may be applied under pre-AIA 35 U.S.C. 102(a) or (b) as of its publication date. See form paragraphs 7.08.fti and 7.09.fti.
6. In bracket 3, insert --assignee--, --applicant--, or --joint inventor--.
7. This form paragraph must be preceded by either of form paragraphs 7.12.fti or 7.12.01.fti.
8. Patent application publications may only be used if this form paragraph was preceded by form paragraph 7.12.fti.
9. For applications with an actual filing date on or after March 16, 2013, that claim priority to, or the benefit of, an application filed before March 16, 2013, this form paragraph must be preceded by form paragraph 7.06.
10. Under 35 U.S.C. 101, two patents are not permitted to issue on identical subject matter. Any claims in the instant application directed to the same invention claimed in the reference should be rejected (or provisionally rejected if the reference has not yet issued as a patent) using form paragraphs 8.30 - 8.32. Additionally, the applicant should be required to resolve any issue of priority under pre-AIA 35 U.S.C. 102(g) and possibly pre-AIA 35 U.S.C. 102(f) using form paragraph 8.27.fti. See MPEP § 804, subsection II.A.
11. Any claims in the instant application that are directed to subject matter that is not patentably distinct from an invention claimed in the reference should be rejected (or provisionally rejected if the reference has not yet issued as a patent) on the grounds of nonstatutory double patenting using form paragraph 8.33 and at least one of form paragraphs 8.34 - 8.39.

¶ 7.15.03.fti Rejection, pre-AIA 35 U.S.C. 102(e), No Common Assignee or Inventor(s)

Claim(s) **[1]** is/are rejected under pre-AIA 35 U.S.C. 102(e) as being **[2]** by **[3]**.

Examiner Note:

1. This form paragraph is used to reject over a patent or patent application publication with an earlier filing date. The patent or patent application publication is not required to have a common assignee or a common inventor.

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2. Pre-AIA 35 U.S.C. 102(e) as amended by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 (form paragraph 7.12.fti) must be applied if the reference is one of the following:

a. a U.S. patent or a publication of a U.S. application for patent filed under 35 U.S.C. 111(a);

b. a U.S. patent issued directly or indirectly from, or a U.S. or WIPO publication of, an international application (PCT) if the international application has an international filing date on or after November 29, 2000;

c. a U.S. patent issued from, or a WIPO publication of, an international design application that designates the United States.

See the Examiner Notes for form paragraph 7.12.fti to assist in the determination of the pre-AIA 35 U.S.C. 102(e) date of the reference.

3. Pre-AIPA 35 U.S.C. 102(e) (form paragraph 7.12.01.fti) must be applied if the reference is a U.S. patent issued directly, or indirectly, from an international application filed prior to November 29, 2000. See the Examiner Notes for form paragraph 7.12.01.fti to assist in the determination of the pre-AIPA 35 U.S.C. 102(e) date of the reference.

4. In determining the pre-AIA 35 U.S.C. 102(e) date, consider benefit claims to earlier-filed U.S. provisional applications under 35 U.S.C. 119(e), and to earlier-filed U.S. nonprovisional applications and international applications under 35 U.S.C. 120, 121, 365(c), or 386(c) if the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application's disclosure (and any intermediate application(s)). A benefit claim to a U.S. patent of an earlier-filed international application, which has an international filing date prior to November 29, 2000, may only result in an effective U.S. filing date as of the date the requirements of 35 U.S.C. 371(c)(1), (2) and (4) were fulfilled. Do NOT consider any benefit claims to U.S. applications which are filed before an international application that has an international filing date prior to November 29, 2000. Do NOT consider foreign priority claims under 35 U.S.C. 119(a) - (d), 365(a) or (b), or 35 U.S.C. 386(a) or (b).

In addition, a reference (i.e., a U.S. patent, published U.S. patent application, or WIPO publication) is entitled to the benefit of the filing date of a provisional application only if at least one of the claims in the reference is supported by the written description of the provisional application in compliance with 35 U.S.C. 112(a). See *Dynamic Drinkware, LLC, v. National Graphics, Inc.*, 800 F.3d 1375, 116 USPQ2d 1045 (Fed. Cir. 2015).

5. If the reference is a publication of an international application (PCT), including voluntary U.S. publication under 35 U.S.C. 122 of the national stage or a WIPO (PCT) publication, that has an international filing date prior to November 29, 2000, did not designate the United States or was not published in English by WIPO, do not use this form paragraph. Such a reference is not a prior art reference under pre-AIA 35 U.S.C. 102(e). The reference may be applied under pre-AIA 35 U.S.C. 102(a) or (b) as of its publication date. See form paragraphs 7.08.fti and 7.09.fti.

6. In bracket 2, insert either --clearly anticipated-- or --anticipated-- with an explanation at the end of the paragraph.

7. In bracket 3, insert the prior art relied upon.

8. This form paragraph must be preceded by either of form paragraphs 7.12.fti or 7.12.01.fti.

9. Patent application publications may only be used if this form paragraph was preceded by form paragraph 7.12.fti.

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